

## **I. Prosecution Reopened**

In paragraph 1 of the Office Action, the Examiner indicates that prosecution is reopened in response to the Decision by the Board of Patent Appeals and Interferences which reversed the rejections and remanded the application to the Examiner for further consideration.

Specifically, the Examiner was ordered to (1) determine whether the ink receiving layer exemplified in Arai '118 is identical to or substantially identical to the claimed stretched porous resin film; and (2) determine whether the combined teachings of Arai '118 and Appellants' admission (based on specific Japanese language references mentioned in the specification) would have rendered the claimed stretched porous resin film obvious.

The Examiner states that neither one of Arai '118 nor the cited Japanese patents teaches or suggests the porous ink receiving layer, but that, upon further consideration, the ink receiving layer exemplified in Arai et al '487 (as the English equivalent of WO 99/46117) is identical to or only slightly different than the claimed stretched porous resin film. The Examiner further states that prosecution on the merits of the application is reopened as to claims 1-6, 8-11, and 13-19.

For the record, Applicants note that the Board further indicated that if any of the above determinations results in a new ground of rejection, the Examiner should reopen prosecution of the application. Therefore, since the Examiner has cited a new reference and made a new rejection, prosecution of the application is reopened as to all claims pending, i.e., claims 1-6, 8-11, 13-19 and 20-21, even though the new reference was not applied to claims 20 and 21.

## **II. Response to Claim Rejections**

### **A. The Examiner's Position**

#### **1. 35 U.S.C. § 102/103**

Claims 1-8 and 13-19 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over WO 99/46117. US 6,632,487 to Arai et al is relied on as an equivalent form of WO 99/46117 and cited in the Office Action.

#### **2. 35 U.S.C. § 103(a)**

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 99/46117 as applied to claim 1 above, and further in view of JP 07-195827.

### **B. Applicants' Response**

Applicants respectfully traverse the rejections and submit that Arai et al WO '117 (or its counterpart Arai et al U.S. '487) does not disclose, teach or suggest the presently claimed invention.

The present invention as recited in claim 1 is a stretched porous resin film that is made from a composition consisting essentially of 30 to 100% by weight of a thermoplastic resin comprising 5 to 100 parts by weight of a hydrophilic thermoplastic resin per 100 parts by weight of a non-hydrophilic thermoplastic resin and 0 to 70% by weight of at least one of an inorganic fine powder and an organic fine powder. The obtained film has a liquid absorbing capacity of 0.5 ml/m<sup>2</sup> or more as measured in accordance with Japan TAPPI No. 51-87.

In Example 10, Arai et al discloses a sheet for an aqueous ink-jet recording medium comprising an ink-receiving layer and a substrate. The Examiner alleges that the ink-receiving layer of Example 10 of Arai et al is identical to, or only slightly different from, the porous resin film of the present invention.

The ink-receiving layer of Example 10 of Arai '487 is prepared by obtaining a resin powdery composition containing 100 parts of a styrene-acrylic copolymer and 30 parts of a water-soluble resin, which has an average particle diameter of 11.0  $\mu\text{m}$ . Then, 95 parts of the resin powdery composition and 5 parts of hydrophilic silica particles are mixed to obtain a powdery coating mixture, which is sprayed on and adhered to the entire surface of a commercially available ordinary paper using a commercially available electrostatic spray device. The powdery coating mixture is fixed on the ordinary paper by heating at about 80 to 100°C under pressure. At the same time, the particles of the coating mixture are partially melted and adhered to each other, thereby forming a resin layer as the ink-receiving layer of Arai '487, which has a thickness of 20  $\mu\text{m}$  and gaps between the particles.

Thus, the resin powdery composition of Arai et al (Example 10) cannot form an independent self-supporting ink-receiving layer and is completely different from the stretched porous resin film of the present invention. That is, the ink-receiving layer of Arai et al (Example 10) formed on an ordinary paper is completely different from the stretched porous resin film of the present invention formed from the composition recited in the present claims. The composition of the present invention is kneaded in an intermeshing twin-screw extruder at a screw shear rate of 300  $\text{sec}^{-1}$  to produce a porous resin film and the porous resin film is stretched. The stretched porous resin film of the claimed invention is capable of being used

alone (self sufficient or self supporting) or may be combined to form a laminate. See, e.g., page 24, lines 5-8 of the specification. Thus, the terms "film" and "stretched" in the present claims define structural and physical elements of the claimed invention that distinguish it from the ink receiving layer of Arai et al. The ink-receiving layer of Arai et al said to correspond to the stretched porous resin film of the present invention cannot be stretched and does not form a film within the scope of the present invention. Therefore, the claimed invention as recited in independent claim 1 is not anticipated by Arai et al.

In addition, Arai et al does not teach or suggest a stretched porous resin film as recited in independent claim 1 of the present invention and there is no motivation for one of ordinary skill in the art to modify the disclosure of Arai et al with a reasonable expectation of success in achieving the claimed invention. Thus, the claimed invention is not rendered obvious.

With respect to the rejection of claim 11 over Arai et al in view of JP '827, JP '827 does not remedy the deficiencies of Arai et al as discussed above. Specifically, JP '827 also fails to disclose, teach or suggest a stretched porous resin film as claimed. Thus, one of ordinary skill in the art would not have been motivated to combine the references with a reasonable expectation of achieving the claimed invention. Even if combined, the present invention would not have been achieved since neither of the references teaches a stretched porous resin film within the scope of the present invention.

Further, Arai et al does not describe the invention recited in claims 20 and 21 of the present application, which depend from independent claim 1.

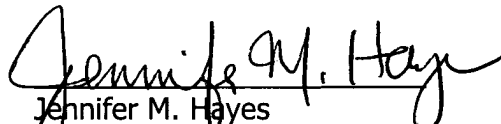
In view of the above, the claimed invention is not anticipated nor rendered obvious by the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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